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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,341	02/07/2002	Hubert Barth	6386-08-IM	3756

7590 08/04/2003  
Charles W Ashbrook  
Warner-Lambet Company  
2800 Plymouth Road  
Ann Arbor, MI 48105

EXAMINER

SHIAO, REI TSANG

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/889,341

Applicant(s)

BARTH ET AL.

Examiner

Robert Shiao

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on application received on 02/07, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-5 are pending in the application.

### *Election/Restrictions*

2. This application contains the following inventions or groups of inventions, which are not so linked as to form a single inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, e.g., R1, R2, R3, R4, R5, HAL, and HETN in claim 1 or claim 2, and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

- I Claims 1, 3-5, drawn to a process for making a compound of formula XIV, wherein R1, R2, R3, R4, and R5 are independently hydrogen, nitro group, or cyano group, alkylcarbonyl, arylcarbonyl or an amide group; and HAL is halogen.
- II Claims 1, 3-5, drawn to a process for making a compound of formula XIV, wherein R1, R2, R3, R4, and R5 are independently hydrogen, nitro group, or cyano group, alkylcarbonyl, arylcarbonyl or an amide group; and HAL is the compounds of formulae V or VI.
- III Claims 1, 3-5, drawn to a process for making a compound of formula XIV, wherein R1, R2, R3, R4, and R5 are independently hydrogen, nitro group,

or cyano group, alkylcarbonyl, arylcarbonyl or an amide group; and HAL is the compounds of formulae VII.

- IV Claims 1, 3-5, drawn to a process for making a compound of formula XIV, wherein R1, R2, R3, R4, and R5 are independently hydrogen, nitro group, or cyano group, alkylcarbonyl, arylcarbonyl or an amide group; and HAL is the compounds of formulae VIII or IX.
- V Claims 1, 3-5, drawn to a process for making a compound of formula XIV, wherein R1, R2, R3, R4, and R5 are independently hydrogen, nitro group, or cyano group, alkylcarbonyl, arylcarbonyl or an amide group; and HAL is the compounds of formulae X or XI.
- VI Claims 2-5, drawn to a process for making a compound of formula I, wherein R1, R2, R3, R4, and R5 are independently hydrogen, nitro group, or cyano group, alkylcarbonyl, arylcarbonyl or an amide group; and HETN is benzotriazole.
- VII Claims 2-5, drawn to a process for making a compound of formula I, wherein R1, R2, R3, R4, and R5 are independently hydrogen, nitro group, or cyano group, alkylcarbonyl, arylcarbonyl or an amide group; and HETN is imidazole.

VIII Claims 2-5, drawn to a process for making a compound of formula I, wherein R1, R2, R3, R4, and R5 are independently hydrogen, nitro group, or cyano group, alkylcarbonyl, arylcarbonyl or an amide group; and HETN is indole.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhaustive, as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compound claimed contain a phenylindole moiety, which does not define a contribution over the prior art (as can be seen by the compound II of CAS: 123:55807). The substituents on the phenyl vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unit of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications

in understanding the claimed subject matter impose a burden on any examination of the claimed subject matter.

3. Applicants are advised that the reply to this requirement to be complete must include an election of invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


#### ***Telephone Inquiry***

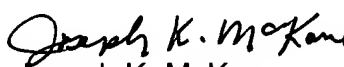
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (703) 308-4002. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (703) 308-4537. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Art Unit: 1626

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

July 29, 2003